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Supreme Court of the United States

October Term, 1943

No. 301

RADIANT POINT PEN CORPORATION,
Petitioner,

against

C. HOWARD HUNT PEN COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND JUDICIAL CIRCUIT, AND SUPPORTING BRIEF.

ASHER BLUM,
Counsel for Petitioner.

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Summary Statement of Matters Involved.

Petitioner is charged with infringement of Henwood Patents No. 2,001,726, dated May 21, 1935, and No. 2,121,541, dated June 21, 1938. The District Court herein (R. 247) has not been officially reported. The Appellate Opinion (R. 273) has been reported in 135 F. (2d) 870.

By stipulation, the documentary exhibits have been bound separately from the printed record, in certified and indexed Exhibit Books. The record was thus presented to the Circuit Court of Appeals. Copies of said Henwood patents are found on pages 1 and 2 of said Exhibit Books.

First Henwood Patent No. 2,001,726 (p. 1 of Exhibit Book).

Fig. 1 shows a flat blank, which has flat wings or tabs 10. The first operation is to bend these wings downwardly, thus providing the downwardly-bent and flat wings 10a which are shown in Fig. 2. The flat and downwardly-bent wings 10a form the writing tip (p. 1, 2d col., ll. 10-22).

It is stated that the flat heel 6 of Fig. I is transversely bent or arched as shown at 6a in Fig. 2, and that the flat body 7 of Fig. I is also transversely arched as shown at 7a in Fig. 2. The description does not say a word about transversely arching or bending the flat blank between the wings 10, out of the original flat shape. Each claim requires that the flat area of the blank which is located between the wings 10, should be left in its original flat condition.

After the bending, the nib is slit at 11 (p. 1, 2d col., ll. 30-32), "between the adjacent tabs 10a-10a".

Claim 1 (ll. 4-6), specifies that these wings or tabs 10 are bent,

> "downwardly approximately 90° at opposite sides of a *central area lying substantially in* in the original plane of the blank".

Hence, this claim clearly requires that after the wings have been bent down, these wings should remain flat and that there shall remain an original flat, unbent area of the blank, between the upper or base edges of the downwardly-bent flat wings. The claim requires that the downwardly-bent wings should be flat, and perpendicular to the flat tip of the blank, and that at said flat tip, each edge of the slit 11 should be separated from the respective flat downwardly-bent wing 10a, by a flat part of the original blank.

Claim 2 also repeatedly requires that a part of the blank should be kept in its original flat condition, between the upper edges of the downwardly-bent flat tongues 10a.

This first Henwood patent is to be compared with British Patent No. 2804 of 1886 to Petit (p. 20 of Exhibit Book).

Petit Patent of 1886.

Figs. 1 and 2 show the downwardly-bent tongues *a*, which are identical with the tongues 10a of the first Henwood patent. Figs. 1, 2 and 13 and other figures of the Petit patent show the conventional slit between these tongues *a*. Figs. 12 and 13 of the Petit patent show that the tongues *a*, are in longitudinal angular relation. In Figs. 1 and 2, said tongues *a* are longitudinally parallel.

The Petit patent states the following (p. 1, beginning at line 15):

> "In making a metallic pen according to my invention I form on each side of the point of the pen a small wing or projection of nearly a semi-circular shape.
>
> These wings or projections are bent towards the underside of the pen and are brought parallel or nearly parallel to each other. The point or writing part of the pen thus consists of two small curved parallel plates almost in contact, the curved edges of which when the pen is used come into contact with the paper or surface and effect the writing."

On page 1, lines 39-46, it is stated:

> "The said wings a, a are situated at right angles or nearly so to the nibs of the pen and their edges are of a nearly semi circular figure. The curved edges of the wings a, a when the point is used come in contact with the paper or surface and effect the writing. The curvature of the edges of the wings a, a prevents the points of the pen entering the paper by the pressure exercised in writing and as the wings

> a, a prevent the sharp edge of the *slit* from touching the paper the scratching of the paper and the spluttering of the pen are avoided."

The District Court sustained the first Henwood patent, solely because the Petit patent did not say in so many words, that the slit should be formed after the wings *a* had been bent down. (R. 257, Finding No. 21 and No. 26.)

The practice always has been, since prior to the grant of the Petit patent, to slit the pen point, after completing all bending operations.

Plaintiff got a patent on this idea of first bending and then slitting, in Hawkes U. S. Patent No. 1,365,318, issued to plaintiff on January 11, 1921 (p. 21 of Exhibit Book). Claim 1 of the Hawkes patent reads:

> "The process of making specially pointed pens which comprises shaping the blank and distorting the point in one operation and in a subsequent operation forming the nibs by slitting the pen through the thus distorted point."

The Hawkes patent expired in 1938. The decisions herein extend its monopoly to the expiration date of the first Henwood patent, in 1952.

The practice of slitting a pen-point, *after* it has been finally bent into shape, has been so universal since at least 1880, that such practice has been stated, even in the popular encyclopedias.

"Encyclopedia Britannica" (1911) Vol. 21, page 83.

This describes the completion of all bending operations,

> "and then the central slit is cut by the aid of two very fine-edged cutters".

"The New International Encyclopedia" (1926), Vol. 18, page 276.

> "The last and perhaps the most important mechanical operation is slitting the pen point."

The same disclosure is found in Knight's "American Mechanical Dictionary" (1880), Vol. 2, page 995, and Vol. 3, pages 2367-2368. On page 2368, after describing all the bending operations, it is stated:

"The central slit is then made by a fly-press."

Hence it was unnecessary for the Petit patent to say in 1886 that the slit was formed after the wings *a* had been bent relative to the body of the blank, because this has been the only practice since 1880, six years prior to the grant of Petit's patent.

Petitioner's method of manufacture of its principal type of pen point, which was held to infringe, is shown in Exhibit CC (p. 25 of Exhibit Book).

Starting from the first tapered blank at the left of Exhibit CC, Steps Nos. 1, 2, and 3 show the formation of a central slot of substantial length in the flat blank, thus forming separated flat tongues. This central slot is formed before the wings are bent, and while the blank is flat. When the blank, including said separated flat tongues, is now bent by petitioner's method, no part of the blank remains flat, intermediate the bent tongues. Defendant bends the entire tip of the blank into V-shape, by means of a sharp tool whose knife edge has a width of only 6/1000 inch (R. 115, 221, 223). The width of a human hair is 4/1000 inch (*Gillette Safety Razor Co.* v. *Essex Blade Corp.*, 83 Ed. (2d) on p. 542). Hence petitioner does not bend the wings, at opposite sides of an original flat and unslitted area of the tip of the blank. After the bending operation, no part of petitioner's blank is in the original plane of the flat blank, save the hair-line which corresponds to the edge of the bending blade. The appellate decision herein (R. 276) requires that the knife edge of petitioner's tool should have a width of even less than 5/1000 inch. This is demanding the impos-

sible. Nobody suggested that it was possible to use a bending blade whose edge was thinner than approximately the width of a hair.

Petitioner's pen does not have the flat, parallel downwardly-bent wings of the first Henwood patent.

Before slitting the pen point behind the wings, petitioner die-molds the downwardly-bent wings into closed ball shape (R. 221). This is shown in Step No. 5 of Exhibit CC (p. 25 of Exhibit Book). The result of this die-molding is shown in Exhibit F, on page 13 of the Exhibit Book (R. 125). Then, and as shown in Step No. 6 of Exhibit CC, the point is slitted behind the ball-shaped wings. This slit is along the hair-line at which the blank was bent. The slitting operation removes the metal along this hair-line. Then the entire blank is transversely arched, as shown in the later steps of Exhibit CC, so that no part of the blank remains flat. There is no finding in the appellate decision, that in petitioner's completed point, any part of the tip of the point remains in the original plane of the original flat blank.

Second Henwood Patent No. 2,001,726.

Plaintiff itself used the method of this second patent, by its own testimony, more than two years prior to its filing date of February 4, 1935.

Plaintiff went on the market in 1932 (R. 43). Its manufacture in 1932 is illustrated by Plaintiff's Exhibit 9 (R. 39, 43). From the beginning in 1932, plaintiff's pen points were opened by swaging, as disclosed in the second Henwood patent (R. 39).

The appellate judgment herein was entered on July 23, 1943 (R. 308).

The jurisdiction to grant this writ was based on Title 28, Section 347, U. S. C. A.

Reasons for Allowance of Writ.

The issues upon which this writ is requested, are the validity and infringement of the two Henwood patents.

There is a clear conflict between the decisions herein, and decisions by other Circuit Courts of Appeal, and the decisions of this Court.

The decisions herein give respondents, according to its own claim, a monopoly of the manufacture of cheap pen points for fountain pens. Respondent testified that it sold 14,500,000 of its pen points per annum (R. 45).

The appellate decision (R. 273) does not even mention the sole reason of the District Court for sustaining the first Henwood patent, because it was so clear that in following Petit's patent, the slitting operation must be subsequent to the bending operation.

As enlarged herein, the first Henwood patent prevents the trade from making Petit's device. Nobody testified that it was possible to use a bending tool, whose edge was of less width than about the width of a human hair. As to Claim 2, respondent's only argument is that if the point is first slitted, the subsequent bending of the wings will distort the previously-formed slit. Assume that this is true, and that the trade then straightens the slit by hand or machine. Claim 2, as a claim for an article of manufacture, as enlarged herein, covers Petit's article, made even according to respondent's interpretation thereof, if such article is straightened, after the slit has been formed.

It has been held in the Sixth Circuit that a claim for an article of manufacture, cannot rely on the method of manufacture (*Westinghouse Elec. & Mfg. Co.* v. *Quackenbush*, 53 Fed. (2d) 632, 634).

To sustain the second Henwood patent, after plaintiff used the same more than two years prior to its filing date, is

contrary to the doctrine of *Muncie Gear Works* v. *Outboard Marine & Mfg. Co.*, 315 U. S. 759.

To sustain the first Henwood patent, after plaintiff had monopolized the same essential idea in its Hawkes patent which expired in 1938 (*supra*, p. 4), is contrary to the doctrine which forbids double patenting, or extension of original monopoly, as stated in numerous decisions of other circuits and of this Court.

Lion Fastener Inc. v. *Hookless Fastener Co.*, 72 Fed. (2d) 985, C. C. A. 3.

Page 988:

"The claims of the second application (and now of the second patent) are distinguishable from those in the first only by greater particularity and corresponding limitations".

"We are constrained to find the inventions of claims 1, 2, 3 and 15 are identical with claims of the first patent. Claims 1, 2, 3 and 15 are therefore invalid for double patenting".

Palmer Pneumatic Tire Co. v. *Lozier*, 90 Fed. 732, C. C. A. 6th.

Page 744:

"One cannot lawfully have two patents for one invention. When once the invention has been used as the consideration of a grant, its value for that purpose is spent, and there is nothing in it on which a second grant can be supported. And this rule holds good though the scope of the two patents may be different. One cannot extract an essential element of his invention from a former patent, without which the former patent would not have been granted, and make it the subject of a subsequent patent. The case of Miller v. Manufacturing Co., 151 U. S. 186, 14 Sup. Ct. 310, is a signal illustration of the rule which has been settled by that and former decisions of the

> supreme court upon that subject. . . . That decision shows that it is not necessary to the rule that the patents should be for co-extensive inventions, or that the subject-matter thereof should be technically the same. The rule rests upon the broad and obvious ground that, if the second patent is for an invention that was necessary to the use of the invention first patented, it cannot be sustained."

This case has been repeatedly cited and followed, as in,

In re Land, 109 Fed. (2d), 246, 249, C. C. P. A.;
Fox Typewriter Co. v. *Corona Typewriter Co.*, 282 Fed. 502, 508, C. C. A. 6th;
Western Electric Co. v. *Williams-Abbott Electric Co.*, 108 Fed. 952, 955, C. C. A. 6th;
Otis Elevator Co. v. *Portland Co.*, 127 Fed. 557, 562, C. C. A. 1st;
Warren Webster & Co. v. *C. A. Dunham Co.*, 181 Fed. 836, 839, C. C. A. 8th;
Century Electric Co. v. *Westinghouse Electric & Mfg. Co.*, 191 Fed. 350, 352, C. C. A. 8th.

The doctrine of double patenting is applicable to a case in which the two patents are issued to different patentees, because the principle is to forbid extension of an expired patent monopoly.

American Safety Razor Corporation v. *Frings Bros.*, 62 Fed. (2d) 416, 417, C. C. A. 1st.

> "Moreover, courts in dealing with an art, originally pioneer in origin, must carefully scrutinize the constant efforts of those who have enjoyed a profitable patent monopoly to lengthen such monopoly by patents for non-inventive change."

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this

Honorable Court directed to the United States Circuit Court of Appeals for the Second Judicial Circuit, commanding that Court to certify and send to this Court for its review and determination, on a day certain to be therein named, a transcript of the record and proceedings herein; and that the judgments of said United States Circuit Court of Appeals and of the District Court be reversed; and that your petitioner shall have such other and further relief in the premises as to this Honorable Court may seem meet and just.

ASHER BLUM,
Counsel for Petitioner.

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